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09/993,926	11/13/2001	Dominic Dough-Ming Cheung	9623.381	5426
56020 7590 10/31/2008 BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE P.O. BOX 10395 CHICAGO, IL 60610				
EXAMINER TINKLER, MURIEL S				
ART UNIT 3691		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/993,926

## Applicant(s)

CHEUNG ET AL.

## Examiner

MURIEL TINKLER

## Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-50 is/are pending in the application.
- 4a) Of the above claim(s) 24-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-23 and 37-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date 6/16/2008

### **DETAILED ACTION**

This application has been reviewed. Claims 1, 2 and 5-50 are pending. Claims 24-36 have been withdrawn and claims 1, 19, 37 and 44 have been amended. Therefore, claims 1, 2, 5-23 and 37-50 have been examined. The rejection(s) are as follows.

#### ***Response to Amendment***

1. The amendments have been reviewed against the specification and accepted for examination.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 2 5-23 and 37-50 have been considered but are moot in view of the new ground(s) of rejection. The applicant has amended independent claims 1, 19, 37 and 44, therefore a new grounds of rejection is warranted.
3. The Applicant also argued, in a response dated July 20, 2007 (page 12), that Davis et al. (US 6,269,361 B1) is not a valid rejection under 35 USC 103(c) because it would be disqualified if used as a section 35 USC 102(e) prior art reference under an obviousness rejection. However, in this Office Action the Examiner uses the Davis et al. reference as a section 35 USC 102(a) prior art reference within an obviousness rejection. The filing date for this application is November 13, 2001. The published date for Davis et al. is July 31, 2001. Therefore, the Examiner does not rely on the Davis et

al. reference under 35 USC 102(e), but rather relies on this reference under 35 USC 102(a), which reads as follows:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Davis et al. at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference Davis et al. additionally qualifies as prior

art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

7. Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

8. Claims 1, 2, 5-9, 13-23 and 37-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (US 6,269,361 B1) in view of Konia (US 7,225,151), hereafter referred to as Davis and Konia respectively.

9. Regarding claims 1, 5, 15, 19 and 23, Davis discloses:

- a. A computer implemented method for a pay for placement search system in the Abstract, "A system and method for enabling information providers using a computer network such as the Internet to influence a position for a search listing within a search result list generated by an Internet search engine."
- b. Storing with a computer one or more search listings associated with an advertiser, each search listing including a respective bid amount, in the Abstract, "each account contains at least one search listing having at least three components: a description, a search term comprising one or more keywords, and a bid amount."
- c. Receiving a bid cap, the specification discloses a bid cap as a maximum dollar amount at which a bid can be set by the system. Davis discloses a bid cap as an 'authorized amount', in column 16 (line 35) through column 17 (line 8).

- d. Adjusting the respective bid amounts for the selected search listings according to the bid and desired rank, in the Abstract, "The system and method of the present invention then compares this bid amount with all other bid amounts for the same search term, and generates a rank value for all search listings having that search term." Also, see column 19, lines 45-49.
  - e. If a tie condition makes a desired rank unavailable for a respective search listing, incrementing a bid amount for the respective search listing, see claim 19, figure 8 (display user entered bid changes) and element 830.
10. However, Davis does not disclose the use of automation in adjusting the bid amounts. Konia, discloses the act of automatically adjusting the bid amounts using computer program code in figure 2 (elements 208, 210 and 212). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Davis to include the act of automatically adjusting the bid amounts, because it will become more difficult for bidders to monitor bids in several different auctions, see Konia (column 1, lines 24-26). Therefore, Konia discloses the need for a system that monitors the current rankings in auctions and automatically adjusts its bids according to the rules defined by its user in column 1 (lines 27-30).
11. Regarding claims 2, Davis discloses increasing bids so long as each respective bid does not exceed the bid cap, see claim 15 and figure 8.
12. Regarding claim 6, Davis discloses reducing the bid amount to a minimum bid necessary to retain the best attainable rank for the selected search listing, see column 19 (lines 13-17) and figure 8 (element 830).

13. Regarding claim 7, Davis discloses reducing the respective bid amounts only if the reduced bid amount exceeds a system minimum, see column 5 (lines 50-55).

14. Regarding claims 8, 9, 22, 39, 40 and 48, Davis discloses if adjusting the bid/rank amount produces no change in the bid/rank, leaving the bid/rank amount unadjusted, on page 6 and lines 32-34, "All search listing changes and modifications are processed substantially in real time to support the online competitive bidding' process." The change order process only works when the amount of the bid has changed. The "Change Bids" process is also illustrated in Davis, Figure 8. So if the bid amount that was entered was equal to the original amount, the amount will stay the same.

15. Regarding claims 13 and 14, Davis discloses providing an error indicating if the desired rank is not within a permitted range of desired ranks see column 14 (lines 9-20).

16. Regarding claim 16, Davis discloses in claim 30, ""enabling a website promoters using a computer network to update information relating to a search listing within a search result list generated by a search engine."

17. Regarding claims 17 and 18, Davis discloses providing a notification/confirmation after adjusting the respective bid amounts and of received bid cap. Claim 18 was dependent on claim 1, which is disclosed based on the discussion(s) above. Davis discloses on page 15 and line 33-40, "Once the advertiser ascertains that the displayed data is correct, the advertiser may click on a "Confirm" button..., which adds money to the appropriate account balance, updates the advertiser's billing information, and appends the billing information to the advertiser's payment history.

18. Regarding claim 20, Davis discloses in claim 14, "programming code for generating in substantially real time a search result list in response to the search request, the search result list including search listings from the accounts on the database, wherein the search term for each search listing in the search result list generates a match with the search request, the search listings in the search result list arranged in an order determined using the bid amounts of the search listings."

19. Regarding claim 21, Davis discloses on page 18 lines and 66-67 through page 19 and lines 1-7, "bid amounts for every search listing displayed, the rank values, and the bid amount needed to become the highest ranked search listing matching the search term field. Preferably, the system then presents a display of changes at step 850. After the user confirms the changes, the system updates the persistent state by writing the changes to the account in the database."

20. Regarding claims 37 and 38, see the rejection of claim 1 above. Davis also discloses receiving a search query matching a selected search listing and forwarding the searcher to a search results list with listing positioned according to rank, see the Abstract, "The rank value generated by the bidding process determines where the network information providers listing will appear on the search results list page that is generated in response to a query of the search term by a searcher located at a client computer on the computer network. A higher bid by a network information provider will result in a higher rank value and a more advantageous placement."

21. Regarding claim 44, see the rejection of claims 1 and 37 above. Davis also discloses producing an advertiser access page in figure 9.



22. Regarding claims 45, 49 and 50, see the rejection(s) of claims 1 and 37 above.

Davis also discloses:

- a. An account management storage system (database) in the Abstract, "The system and method of the present invention provides a database having accounts for the network information providers."
- b. A search engine web server that generates ordered search result lists matching keywords in figure 7
- c. An account management server accessible over a network by advertisers in figure 4

23. Regarding claim 46, Davis discloses a server in figure 1 (element 24), a database in figure 1 (element 40) and search listing records in column 9 (lines 8-18).

24. Regarding claim 47, Davis discloses two servers (search engine-element 24, and account management-element 22) each with their own databases (40 and 32 respectively) connected in column 9 (lines 8-18).

25. Claims 10-12 and 41-43 rejected under 35 U.S.C. 103(a) as being unpatentable over Davis and Konia as applied to claims 1 and 37 above, and further in view of Fraser (US 6,560,580), hereafter referred to as Fraser.

26. Claims 10-11 and 41-43 discuss, processing a requested bid/rank to a higher requested bid/rank produces a bid/rank change to a rank below an initial bid/rank, leaving the bid amount unadjusted only if the bid amount required for the initial rank

does not exceed the bid cap. Davis does not disclose leaving a bid amount unadjusted if a request for a change to a higher rank produces a rank below initial rank. Fraser teaches on page 17 and lines 31-33, "This invention preferably provides ways for the broker to effectively" undo" a trade, either by canceling a pending order, or rolling-back executions during a trade state." Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Davis as taught by Fraser by canceling a change that resulted in a rank below the intended rank if funds are available for the initial rank.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./  
Examiner, Art Unit 3691  
/Hani M. Kazimi/  
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